

Amendments to the Drawings:

The attached sheet of drawing includes changes to Fig. 2, in particular the addition of items designated 15 and 17. This sheet, which contains Figs. 1-3, replaces the original sheet including Figs. 1-3.

Attachment: Replacement sheet

Remarks/Arguments

Reconsideration of the rejections of claims 1-7, 9-12 and 14-16 under 35 USC 103 based on Saunders and of claims 1, 2, 6, 9, 12, 14 and 16 under 35 USC 103 based on Nebeker et al. is respectfully requested. It is applicant's position that both Saunders and Nebeker et al. are nonanalogous prior art and therefore are improper references to be cited against the claims of the application. In particular, Saunders and Nebeker et al. do not meet the "two-step test" adopted by the Federal Circuit in In re Deminski and In re Clay and set forth also in MPEP Section 2141.01(a).

Under the "two-step test", first it must be determined whether the reference is "within the field of the inventor's endeavor". Applicant's field of endeavor is delivering controlled amounts of viscous fluid in the form of drops to a selected location along a surface. Saunders, on the other hand, is in the field of delivering a high velocity liquid jet for cutting operations, such as cutting metals, ceramic, tungsten carbide, diamond and similar hard materials. Nebeker et al., on the other hand, are in the field of creating percussive liquid jets for rock cutting. Furthermore, both Saunders and Nebeker et al. are concerned with using liquid jets to provide a destructive or deforming effect on the surface to which the liquid jets are applied, i.e. cutting rock and other hard materials. Applicant's concern is completely opposite that of Saunders and Nebeker et al. There is no destruction/deforming such as by cutting. The surface to which applicant's invention applies drops of viscous fluid remains intact, i.e. maintains its structural integrity.

In view of the foregoing, it is respectfully submitted that neither Saunders nor Nebeker et al. meets the requirements of the first part of the "two-step test". Under the second part of the "test", it must be determined whether the reference is reasonably pertinent to the problem with which the inventor was involved. A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. In re Clay, 23 USPQ2d (Fed. Cir. 1992). Applicant's problem was delivering controlled amounts of viscous fluid in the form of drops to a selected location along a surface. Obviously, applicant did not want to destroy or deform the surface or remove its structural integrity. Accordingly, Saunders and Nebeker et al. employing high velocity liquid jets and percussive liquid jets for cutting hard materials and thus their surfaces would not logically have commended applicant's attention.

The purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. In re Clay, supra. A purpose of applicant's invention is to conduct viscous fluid from inlet to outlet of the dispensing tip in a continuous and interrupted manner and in a manner avoiding turbulence to fluid flow in the tip so as to maintain consistency in the size and shape of the drops of viscous fluid applied to a surface. No such purpose is found in either Nebeker et al. nor Saunders. In fact, quite the contrary is the purpose of Nebeker et al. in providing percussive liquid jets by virtue of the modulator 20 which generates cyclic variations in

liquid pressure and liquid velocity through the nozzle 24. There is no mention in Saunders of a purpose of avoiding turbulence. Neither Nebeker et al. nor Saunders has a purpose of maintaining consistency in the size and shape of drops of viscous fluid applied to a surface.

In view of the foregoing, neither Saunders nor Nebeker et al. satisfies the "two-part test" of analogous prior art. Therefore, both Saunders and Nebeker et al. constitute non-analogous prior art and are improper references against the claims of the instant application. Accordingly, the rejections of claims 1-7, 9-12 and 14-16 under 35 USC 103 based on Saunders and of claims 1, 2, 6, 9, 12, 14 and 16 under 35 USC 103 based on Nebeker et al. are deemed to be improper, and it is respectfully requested that they be withdrawn.

The rejection of claims 3-5, 10 and 11 under 35 USC 103 based on Nebeker et al. in view of Saunders is respectfully traversed. For the reasons set forth above, Nebeker et al. and Saunders are considered to be non-analogous prior art and not proper references against the claims of the instant application. Accordingly, it is respectfully requested that this rejection be withdrawn.


The rejection of claims 14 and 15 under 35 USC 103 based on Nebeker et al. in view of Vickers is respectfully traversed. For the reasons set forth above, Nebeker et al. is considered to be non-analogous prior art and not a proper reference against the claims of the instant application. Accordingly, it is respectfully requested that this rejection be withdrawn.

New claims 17-21 are submitted to give applicant the full measure of protection for his invention to which he is believed

to be entitled. Fig. 2 and the related portion of the specification are amended to illustrate an aspect of the claimed subject matter. Favorable action on new claims 17-21 is respectfully requested.

In view of the foregoing, favorable action on this application is respectfully requested.

Respectfully submitted,
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